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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/588,364 06/02/00 OSHIMA

M MTS-520US1

EXAMINER

TM02/0322

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KARAKOFF, S

ART UNIT

PAPER NUMBER

2132

DATE MAILED:

03/22/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.

09/588,364

Applicant(s)

OSHIMA ET AL.

Examiner

Steve Kabakoff

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☒ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

### DETAILED ACTION

1. Claims 1-29 have been examined.
2. Claims 1-27 were allowed in parent application 08/560,056, issued as U.S. Patent 5,761,301 (June 2, 1998). However, the current Examiner has found newly cited prior art that is applied to these claims in the current Office Action. The original Examiner did not indicate reasons for allowing claims 1-27 in parent application 08/560,056, issued as U.S. Patent 5,761,301 (June 2, 1998).
3. The applicant added new claims 28 and 29 to get broader coverage of the subject material in allowed claims 1-27, and new claims 28 and 29 have been rejected as will be discussed below.

### *Reissue Applications*

4. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.
5. This reissue application was filed with an offer to surrender the original patent signed by one of the inventors, Mitsuaki Oshima, and not the other inventor. The offer to surrender by Mitsuaki Oshima is rejected to because it is unnecessary in light of the submitted offer to surrender the original patent signed by Osamu Yamazaki on behalf of the assignee, Matsushita Electric Industrial Co., Ltd. See 37 CFR 1.178.

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***Certificate Under 37 CFR 3.73(b)***

6. The 37 CFR 3.73(b) submission received is objected to because the first paragraph of certificate reads:

"Matsushita Electric Industrial Co., Ltd., a Japanese Corporation certifies that it is the assignee of the entire right, title, and interest in the patent application identified above by virtue of an assignment from the inventor of **the patent application identified above**. The assignment was recorded in the Patent and Trademark Office at Reel 7884, Frame 0122, for which a copy thereof is attached" (emphasis added)

However, no application was identified above this statement and therefore the Certificate Under 3.73(b) is deficient and must be corrected.

***Information Disclosure Statement***

7. A new Information Disclosure Statement (Form PTO-1449) needs to be submitted for the current reissue application if the applicants desire consideration of the same prior art submitted by the applicants in parent application 08/560,056, issued as U.S. Patent 5,761,301 (June 2, 1998).

***Priority***

8. Receipt is acknowledged of papers filed under 35 U.S.C. 119 (a)-(d) based on an applications filed in Japan on November 17, 1994 and February 2, 1995 and October 9, 1995. Applicant has not complied with the requirements of 37 CFR 1.63(c), since the oath or declaration does not acknowledge the filing of any foreign application. A new oath or declaration is required in the body of which the present application should be identified by application number and filing date. In order to claim the same foreign priority as originally filed case 08/560,015, the applicant must identify the foreign priority documents by specifying the

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application number, country, day, month, and year of their filing as required by 37 CFR 1.63(c) [see MPEP 1414].

### ***Drawings***

9. Applicant must provide a copy of the drawings in addition to the "Request for Transfer of Drawings from Original Patent to Reissue Application." See MPEP 1413 and 37 CFR 1.174 below.

#### **37 CFR 1.174. Drawings**

(a) The drawings upon which the original patent was issued may be used in reissue applications if no changes whatsoever are to be made in the drawings. In such cases, when the reissue application is filed, the applicant must submit a temporary drawing which may consist of a copy of the printed drawings of the patent or a photoprint of the original drawings of the size required for original drawing.

### ***Reissue Oath / Declaration***

10. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

The applicants' oath/declaration states the original patent is wholly or partially inoperative or invalid since "the inventors did not recognize that the features disclosed at page 31, line 23 to page 32, line 15 were appropriate to claim." However, not knowing what to claim is not a sufficient indication of an "error" relied upon to support a reissue application.

**MPEP § 1414, paragraph II** states: "In identifying the error, it is sufficient that the reissue oath/declaration identify a single word, phrase, or expression in the specification or in an original claim, and how it renders the original patent wholly or partly inoperative or invalid" [emphasis added].

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**MPEP § 1444** further elaborates:

Where the initial reissue oath/declaration (1) failed to provide any error statement, or (2) attempted to provide an error statement, but failed to identify any error under 35 U.S.C. 251 upon which reissue can be based (see MPEP § 1402), the examiner should reject all the claims as being based upon a defective reissue oath/declaration under 35 U.S.C. 251. To support the rejection, the examiner should point out the failure of the initial oath/declaration to comply with 37 CFR 1.175 because an error under 35 U.S.C. 251 upon which reissue can be based was not identified therein. In reply to the rejection under 35 U.S.C. 251, a supplemental reissue oath/declaration must be submitted stating an error under 35 U.S.C. 251 which can be relied upon to support the reissue application. Submission of this supplemental reissue oath/declaration to obviate the rejection cannot be deferred by applicant until the application is otherwise in condition for allowance. In this instance, a proper statement of error was never provided in the initial reissue oath/declaration, thus a supplemental oath/declaration is required in reply to the Office action in order to properly establish grounds for reissue. [emphasis added]

***Claim Rejections - 35 USC § 251***

11. Claims 1- 29 are rejected as being based upon a defective oath/declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

***Claim Rejections - 35 USC § 112***

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claim 13 recites the limitation "said optical disk" in the description of the "reproducing means." There is insufficient antecedent basis for this limitation in the claim.

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***Claim Rejections - 35 USC § 102***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 1, 2, 12-14, 21, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Cato et al (US 4758058).

As per claim 1, the claimed invention teaches applying at least one marking to at least one reflective film formed on a disk, detecting the position of the marking, and outputting position information of the mark.

As per claim 2, the claimed invention limits claim 1 so the outputted position information is written to the disk or a different medium.

Cato et al (US 4758058) teaches storing “position-indicating holograms” (see abstract and col. 3, lines 52-60) on a disk such that the position-indicating holograms store information pertaining to their relative position on the disk. The position-indicating holograms are tantamount to the claimed marking; furthermore, the position-indicating holograms in Cato et al (US 4758058) comprise the “position information of said marking” written on the disk.

The Examiner asserts it is well known to create holograms by marking reflective film on a substrate (usually a metallic, photorefractive film is used), and Cato et al (US 4758058) explicitly teaches reflective material used for the position-indicating holograms in column 5, lines 41-43.

Thus, claims 1 and 2 are fully disclosed by the teachings in Cato et al (US 4758058).

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As per claim 12, Fig. 5 and column 5, lines 63-67 explicitly disclose the claimed limitations of claim 12.

As per claim 13, the claimed invention comprises the limitations of previously rejected claims 1 and 2, and in addition teaches a comparison between the position information and the result of reading the "marking reading means" position measurement, and consequently reproducing recorded data on the disk in accordance with that comparison.

Cato et al (US 4758058) also teaches comparing the position information stored in holograms on a disk with an absolute disk position (see column 5, lines 20-32, and comparator circuits for judging the "Home" position illustrated in Fig. 7) and clearly one skilled in the art would use the comparison to properly align the disk before any more data is read back from the disk. In Cato et al (US 4758058), the comparison of position information is used as feedback for controlling amplifier gains, focal lengths, etc. for assuring proper positioning and readback from the disk (column 5, lines 32-40).

As per claims 14, 21, and 26, the claimed inventions contain the same limitations as previously rejected claims 1, 2, 12, and 13 and are rejected for the same reasons.

16. Claims 28 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Ikeda (US 5050150).

As per new claims 28 and 29, the claimed inventions teach an optical disk and its associated method of manufacture such that the disk comprises (a) an embossed data zone having pits and projections indicating data signals that are readable by light irradiation and (b) a barcode pattern formed on the embossed data zone indicating information.

In Fig. 1, Ikeda (US 5050150) discloses an optical disk comprising an embossed data zone having pits and projections indicating data signals that are readable by light irradiation,



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although the Examiner notes that almost all compact disks (CD) known in the art at the time of the invention having data recorded in pre-pits situated in a land/groove arrangement would meet limitation (a) of the claimed inventions.

Ikeda (US 5050150) also discloses a barcode pattern formed on the embossed data zone (Figs. 1 and 2 and col. 2, lines 39-41) where the barcode pattern indicates information (col. 2, lines 1-3). Thus, Ikeda (US 5050150) also discloses limitation (b) of the claimed inventions.

### ***Allowable Subject Matter***

17. Claims 3-11, 15-20, 22-25, and 27 are allowable over the prior art of record.

The limitation of encrypting outputted position information or applying a digital signature to outputted position information and writing the result of encrypting or digitally signing the position information onto a disk using an apparatus as claimed was not found in a single reference nor in a combination of references in the prior art of record.

### ***Conclusion***

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Nakajo (US 5502702) – see Fig. 3

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Kabakoff whose telephone number is (703) 306-4153. The examiner can normally be reached on 8:30am to 6:00pm except every other Friday.

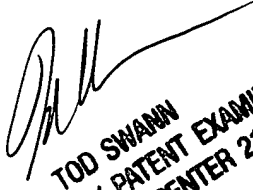
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tod Swann can be reached on (703) 308-7791. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 305-0040 for regular communications and (703) 305-9051 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

SK  
SEK  
March 21, 2001

  
TOD SWANN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100